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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,023	07/28/2000	Shigeo Yamagata	35.C14654	2202

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/628,023	Applicant(s) YAMAGATA ET AL.	
	Examiner Thierry L Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 12/20/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14, 17-20, 24-27 and 31-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 17-20, 24-27, 31-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 12/20/04.
- Amendment After Final filed on 9/23/04 has been entered.
- Claims 1-8, 15-16, 21-23, 28-30, and 49-63 have been canceled; Claims 9-14, 17-20, 24-27, 31-48 are pending in application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/04 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-14, 17-20, 24-27, 31-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakai et al (U.S. 5909602).

Regarding claim 9, Nakai discloses an image processing apparatus (copy machine 93, fig. 11), comprising:

- receiving means (receiving image data from plurality of different sources via I/F interface, i.e., ref. 91-92, ref. 94, fig. 11) for receiving color image data from any of an image generating apparatus having a forgery judging function and an image generating apparatus not having a forgery judging function;

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- judging means (copy machine 93 also includes PCU 74 of fig. 4 for judging confidential contents of received image data, i.e., paper money, col. 31, lines 28-67) for judging whether a color image composed of the color image data received by said receiving means is a specific image; and
- output means (copy machine 93 also includes image data output portion 72 (fig. 4) for outputting image data receiving from plurality of external sources, fig. 11) for outputting the color image data so as to make an image forming unit form a color image by using the color image data received from said receiving means, wherein the image processing apparatus controls formation of the color image according to a result of judgment in the image generating apparatus having the forgery judging function (received image data that has a confidential marks will print with lower resolution and/or not printing at all, cols. 31-35) if the color image data is generated by the image generating apparatus having the forgery judging function (copy machine 93 receives image data from plurality of external devices, i.e. copy machine 92-91 which also includes a judgment means PCU 74 or scanner 94, fig. 11, cols. 31-35), and controls formation of the color image according to a result of judgment by said judging means if the color image data is generated by the image generating apparatus not having the forgery judging function (image data received from scanner 94 (which does not include any forgery judging function) will be printed normally and/or if the received image data contains no confidential contents, then the normal printing is carried out, cols. 31-35).

Regarding claim 10, Nakai further discloses the image processing apparatus according to claim 9, wherein the image generating apparatus is a scanner (scanner 94, fig. 11) or a digital camera.

Regarding claim 11, Nakai further discloses the image processing apparatus according to claim 9, wherein the specific image is a security such as bank note, and a traveler's check (securities, col. 31, lines 10-17).

Regarding claim 12, Nakai further discloses the image processing apparatus according to claim 9, wherein said judging means judges the color image data by pattern matching (col. 31,

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lines 35-36) or color matching, or judges digital water mark information included in the color image.

Regarding claim 13, Nakai further discloses the image processing apparatus according to claim 9, wherein the image generating apparatus having a forgery judging function transmits a result of the forgery judgment ahead of the color image data (copy machine 92 includes a lower judging means for judging the image data prior sending to copy machine 93 for higher judging means, fig. 40, cols. 33-34).

Regarding claim 14, Nakai further discloses the image processing apparatus according to claim 9, wherein said receiving means receives the color image data via a network (network, fig. 11).

Regarding claim 17, Nakai further discloses an image processing method, comprising the steps:

- receiving (receiving image data from plurality of different sources via I/F interface, i.e., ref. 91-92, ref. 94, fig. 11) color image data from any of an image generating apparatus having a forgery judging function and an image generating apparatus not having a forgery judging function;
- judging (copy machine 93 also includes PCU 74 of fig. 4 for judging confidential contents of received image data, i.e., paper money, col. 31, lines 28-67) whether a color image composed of the color image data received by said received step is a specific image; and
- outputting (copy machine 93 also includes image data output portion 72 (fig. 4) for outputting image data receiving from plurality of external sources, fig. 11) the color image data so as to make an image forming unit form a color image by using the color image data received, wherein the image processing method further comprises the steps of controlling formation of the color image according to a result of judgment in the image generating apparatus having the forgery judging function (received image data that has a confidential marks will print with lower resolution and/or not printing at all, cols. 31-35) if the color image data is generated by the image generating apparatus having the forgery judging function (copy machine 93 receives image data

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from plurality of external devices, i.e. copy machine 92-91 which also includes a judgment means PCU 74 or scanner 94, fig. 11, cols. 31-35), and controlling formation of the color image according to a result of judgment by said judging step if the color image data is generated by the image generating apparatus not having the forgery judging function (image data received from scanner 94 will be printed normally and/or if the received image data contains no confidential contents, then the normal printing is carried out, cols. 31-35).

Regarding claim 18, Nakai further discloses an image processing system (image processing system, fig. 11) that has:

- a first apparatus (i.e. copy machine 92, fig. 11) inputting an image signal, and a second apparatus (copy machine 93, fig. 11) outputting an image by using the image signal, wherein said first apparatus comprises first judging means for comparing the image signal (copy machine 92 includes a simple copy-prohibited judging means, col. 33, lines 40-52), read by said first apparatus, with data corresponding to a specific image,
- wherein said second apparatus (copy machine 93 has a higher level of judging means for judging the image data received from copy machine 92, fig. 11, cols. 33-35) has second judging means for comparing the image signal with data corresponding to a specific image, and
- wherein said first judging means in said first apparatus inputting the image signal and said second judging means in said second apparatus outputting the image perform judgment of different specific images (both copy machines 92-93 for detecting plurality of different confidential marks, cols. 31-34).

Regarding claim 19, Nakai further discloses the image processing system according to claim 18, wherein the data corresponding to a specific image is a pattern data (i.e. paper money, col. 31, lines 10-20).

Regarding claim 20, Nakai further discloses the image processing system according to claim 18, wherein the data corresponding to a specific image is digital water-mark data (inherently, paper money includes a digital water mark, col. 31, lines 10-20).

Regarding claim 24, Nakai further discloses the image processing system according to claim 18, wherein the said first apparatus is a scanner (copy machine 92 is a multifunctional including a scanner unit, fig.2-3, fig. 11), and the second apparatus is a printer (copy machine 93 is also a multifunctional apparatus including printer unit, figs. 2-3, 11).

Regarding claims 25-27 & 31: Claims 25-27 & 31 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 18-20 & 24; therefore, claims 25-27 & 31 are rejected for the same rejection rationale/basis as described in claims 18-20 & 24 above.

Regarding claim 32, Nakai further discloses the image processing method according to claim 25, wherein the data corresponding to a specific image is downloaded from a computer (host computer 96 includes specific image databases, fig. 11).

Regarding claim 33, Nakai further discloses an image processing method, wherein, in response to an image signal inputted not being a specific image as a result of judgment of whether the image signal inputted corresponds to the specific image, the image signal is compressed and stored as an image file (copy machine includes compression unit and memory for storing such images, fig. 3).

Regarding claim 34, Nakai further discloses the image processing method according to claim 33, wherein the specific image is a security (col. 31, lines 10-20), and at least one out of color, a pattern, and a digital water mark is used for the judgment (i.e. paper money, col. 31, lines 10-20).

Regarding claim 35, Nakai further discloses the image processing method according to claim 33, wherein information of a specific image having been already judged is added to the image file (memory 73, fig. 3)

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Regarding claim 36, Nakai further discloses the image processing method according to claim 35, wherein the information of a specific image having been already been judged is protected (prevent confidential information from being printed/copied, cols. 31-32).

Regarding claim 37, Nakai further discloses the image processing method according to claim 33, wherein when an image corresponding to the image file is printed, it is judged whether the image is a specific image (cols. 31-33)

Regarding claim 38, Nakai further discloses the image processing method according to claim 35, wherein the information of a specific image having been already been judged is added to the image file, and judgment at the time of printing is performed on the basis of the additional information (to determine whether high level of judging is required, cols. 31-34).

Regarding claim 39, Nakai further discloses the image processing method according to claim 38, wherein judgment of a specific image having already been judged is omitted on the basis of the additional information (an additional judging is not required, cols. 31-34).

Regarding claim 40, Nakai further discloses an image processing method, comprising the steps of:

- obtaining information that is added to an image file and denotes whether it has been already judged whether the image file includes a specific image (copy machine 93 determines whether the image received from copy machine 92 required a higher level of judging or not, cols. 31-34); and
- judging the image file on specific images, which have not been judged yet, if the judgment has been already performed, and judging the image file on specific images, which can be used for judgment, if not judgment has been performed (cols. 31-34).

Regarding claim 41, Nakai further discloses the image processing method according to claim 40, wherein the specific image is a security, and at least one of color, a pattern, and a digital water mark is used for the judgment (i.e. paper money, col. 31, lines 10-30)

Regarding claim 42, Nakai further discloses the image processing method according to claim 40, wherein the information is protected (confidential contents, col. 31)

Regarding claim 43, Nakai further discloses the image processing method according to claim 40, further comprising the steps of:

- judging that an apparatus generating the image file does not have a specific image judging function (i.e. scanner 94 does not have a judging unit, fig. 11); and
- generating information for supplying the specific image judging function to the apparatus generating the image file (cols. 31-34)

Regarding claim 44, Nakai further discloses the image processing method according to claim 43, wherein the information for supplying the specific image judging function is address information (cols. 31-34).

Regarding claims 45-46, Nakai further discloses the image processing method according to claim 33, wherein the image processing method is implemented by a scanner driver & printer driver (copy machines 91-93 are a multifunctional apparatus, and inherently, these apparatuses includes a driver to perform any image processing steps).

Regarding claim 47, Nakai further discloses an image processing apparatus (fig. 11) realizing the image processing method according to claim 33.

Regarding claim 48, Nakai further discloses a storage medium storing (memory 73, fig. 3) the image file according to claim 33.

Response to Arguments

Applicant's arguments with respect to claims 9, 17-18, 25 and 33 have been considered but are moot in view of the new ground(s) of rejection of newly found prior art reference.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

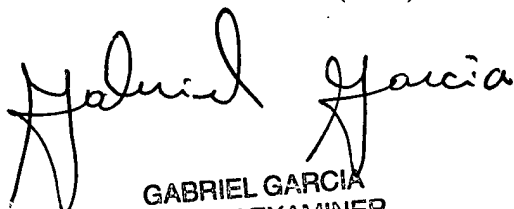
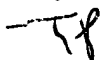
- U.S. 5678155 to Miyaza, teaches an anti-counterfeiting device for use in an image image-processing apparatus.
- U.S. 6185321 to Fukushima et al, teaches an image processing system for preventing illegal copy of confidential materials (i.e., paper money, securities, and etc).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER